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Filing date: **12/08/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224436
Party	Plaintiff JOAN HERLONG
Correspondence Address	Timothy D. St. Clair Nexsen Pruet, LLC 55 East Camperdown Way Suite 400 GREENVILLE, SC 29601 UNITED STATES tstclair@nexsenpruet.com, pweaver@nexsenpruet.com
Submission	Opposition/Response to Motion
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Signature	/Timothy D. St. Clair/
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Attachments	Amended Opposition Petition with Exhibits - for filing.pdf(5432454 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark
Serial No. 86/577749
Filing Date: March 26, 2015
Mark: NUMBER ONE IN THE NEIGHBORHOOD
Publication Date: August 18, 2015

Joan Herlong, Opposer, v. Sharon Wilson, Applicant.	Opposition No. 91224436
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AMENDED NOTICE OF OPPOSITION

Joan Herlong (“Opposer”), an individual with a principal place of business at 1421 Augusta Street, Greenville, South Carolina 29605, United States, believes that she will be damaged by the registration of NUMBER ONE IN THE NEIGHBORHOOD shown in Application Serial No. 86/577749 (“the Application”) filed on March 26, 2015 by Sharon Wilson (“Applicant”) in International Class 36 for use in connection with “real estate agencies,” and hereby opposes the same. Opposer requests that the registration of NUMBER ONE IN THE NEIGHBORHOOD be refused, amending her earlier-filed petition pursuant to FED.R.CIV.P. 15(a)(1)(B).

Opposer’s grounds for this opposition are as follows:

1. For many years, Opposer has conducted business as a real estate agent, and has during that time devoted and expended tremendous energy, time, talent, and

monies toward promoting, advertising, advancing, and operating her business as a real estate agent.

2. As a result, notwithstanding a very competitive environment, Opposer has earned and achieved remarkable success as a real estate agent, and has come to be, and is, viewed in the South Carolina “Upstate” real estate market, and particularly in the Greenville, South Carolina metropolitan area real estate market, as a premier real estate agent. Opposer is widely respected in her field as a leader and as a provider of the highest quality real estate agency services. Her services as a real estate agent are widely sought by prospective real estate sellers and purchasers, based on her record of successes, the quality of her work, and her skills and talents. Opposer enjoys extensive goodwill and consumer recognition in the South Carolina “Upstate” real estate market, and particularly in the Greenville, South Carolina metropolitan area real estate market.

3. On or about March 26, 2015, Applicant filed the referenced application seeking registration of NUMBER ONE IN THE NEIGHBORHOOD for “real estate agencies.” The Application was filed in the name of Sharon Wilson with an address of 111 Williams Street, Greenville, South Carolina 29601. The Application was assigned serial number 86/577749.

4. Applicant’s Application was published for opposition on August 18, 2015. Opposer sought and received a thirty-day extension of time to oppose Applicant’s registration.

5. Applicant’s claimed use of “Number One in the Neighborhood” for real estate agency is unconditional and without limits.

6. Applicant's use of "Number One in the Neighborhood" for real estate agency exceeds a merely boastful claim and instead is a quantifiable aspect of her marketed services.

7. Applicant's use of "Number One in the Neighborhood" suggests that she claims mathematically tested and proven superior quality and enhanced performance of her services.

8. Applicant is not the "Number One in the Neighborhood" for real estate agency:

- a. Applicant does not have the highest number of sales, in any relevant market, over any relevant time period.
- b. Applicant does not have the greatest number of listings, in any relevant market, over any relevant time period.
- c. Applicant's listings do not sell faster than those of other real estate agents, over any aggregation of listings, in any relevant market, over any relevant time period.
- d. Applicant's listings do not sell at a higher price than those of other real estate agents, over any aggregation of listings, in any relevant market, over any relevant time period.
- e. Applicant's services are not of superior quality, in any relevant market, over any relevant time period, compared to those of other real estate agents.

- f. Applicant's services are not of enhanced performance or function, in any relevant market, over any relevant time period, compared to those of other real estate agents.
- g. There is no other known, pertinent metric, in any relevant market, over any relevant time period, by which Applicant is the best, most desirable, finest, first, greatest, highest, maximum, paramount, preeminent, superlative, top, ultimate, unsurpassed, utmost, or otherwise "number one" real estate agent.

For at least these reasons, Applicant's use of "Number One in the Neighborhood" is literally false. Further, for at least these reasons, Applicant's use of "Number One in the Neighborhood" is not merely a general claim of superiority over comparable services that is so vague as to be an opinion; instead, it is factually incorrect and false. Further, or alternatively, for at least these reasons, Applicant's use of "Number One in the Neighborhood" conveys a false impression to prospective real estate sellers and purchasers.

9. Applicant's use of "Number One in the Neighborhood" for real estate agency is misdescriptive of the character and quality of her real estate agency.

10. Applicant's use of "Number One in the Neighborhood" for real estate agency falsely describe the nature of those services.

11. Prospective real estate sellers and purchasers are likely to believe that Applicant's misdescription applies to Applicant's services.

12. Prospective real estate sellers and purchasers are likely to believe that Applicant's misdescription applies to Applicant's services in their neighborhood or neighborhoods of interest.

13. Applicant's misdescription is likely to materially affect a significant portion of prospective real estate sellers' and purchasers' decision to procure Applicant's services and would likely be a material factor in the purchasing decision of a significant portion of the relevant consumers of such services.

14. Applicant's use of "Number One in the Neighborhood" conveys an immediate idea of a quality, characteristic, and/or feature of her services that, though plausible, is false.

15. Applicant's use of "Number One in the Neighborhood" is deceptively misdescriptive.

16. The foregoing is further supported by the following, all of which is known to Applicant:

- a. A first witness has affirmed that he contacted Applicant regarding real estate agency services in 2013 and that the principal reason he contacted her in the first place was because he assumed her "Number One in the Neighborhood" advertisement meant that she was the number one seller in his area. He thereafter felt Applicant's conduct and lack of response as a real estate agent to be inconsistent with being "number one" of anything. This first witness has further affirmed that he believes her advertising is misleading. See Exhibit A.

- b. A second witness, herself a real estate agent, has affirmed that her neighbors in a specific neighborhood in the Greenville, South Carolina metropolitan area notified her of receiving a misleading advertisement from an agent in Applicant's real estate agency, claiming to be "Number One in the Neighborhood." At about the same time, a newsletter for that specific neighborhood contained the same advertisement with the same claim. That particular agent in Applicant's real estate agency had never listed or sold anything in that specific neighborhood. Several other neighbors living in that specific neighborhood notified this second witness that they had noticed the advertisement and found it to be misleading. See Exhibit B.
- c. A third witness, the publisher of a newspaper in the Greenville, South Carolina metropolitan area, affirmed that a few years ago Applicant ran an advertisement in his newspaper which included the line "Number One in the Neighborhood." This third witness thereafter heard negative comments from a number of Realtors, including Opposer. This third witness thereafter declined to run further advertisements from Applicant that included the line "Number One in the Neighborhood" unless Applicant provided documentation with supporting data for the assertion; Applicant has not provided such documentation with supporting data. By comparison, this third witness has run advertisement from Opposer

that state that she is the number one individual Realtor in Greenville, because Opposer has corroborated that statement with factual supportive data. See Exhibit C.

- d. Upon information and belief, some third-party or third-parties not Opposer has complained of Applicant's use of "Number One in the Neighborhood" to a "better business bureau in the Greenville, South Carolina metropolitan area in the past, as is known by Applicant.

17. By reason of all of the foregoing, Opposer will be damaged by the registration of Applicant's NUMBER ONE IN THE NEIGHBORHOOD phrase.

18. Pursuant at least to *15 U.S.C. § 1052(a)* and such other laws, rules, and authorities made and provided, registration of Applicant's NUMBER ONE IN THE NEIGHBORHOOD phrase, Application Serial No. 86/577749, for "real estate agencies" should be rejected.

WHEREFORE, Opposer prays that the application for registration of NUMBER ONE IN THE NEIGHBORHOOD, Application Serial No. 86/577749, for "real estate agencies" be rejected, that this opposition be sustained, and that Opposer be granted such other different and additional relief as this Board deems just and proper.

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[signature on next page]

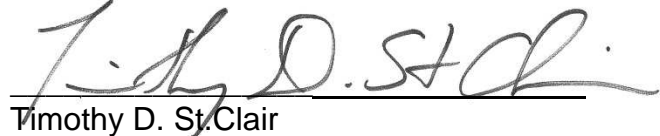
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Respectfully submitted,

NEXSEN PRUET, LLC

A handwritten signature in black ink, appearing to read "T. D. St. Clair", written over a horizontal line.

December 8, 2015

Timothy D. St. Clair
55 E. Camperdown Way, Suite 400
Greenville, South Carolina 29601
Telephone: (864) 282-1181
Facsimile: (864) 477-2634
e-mail: tstclair@nexsenpruet.com

ATTORNEYS FOR OPPOSER

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark
Serial No. 86/577749
Filing Date: March 26, 2015
Mark: NUMBER ONE IN THE NEIGHBORHOOD
Publication Date: August 18, 2015

Joan Herlong,

Opposer,

v.

Sharon Wilson,

Applicant.

CERTIFICATE OF SERVICE

I, Timothy D. St.Clair, attorney of Nexsen Pruet, LLC, attorneys for Opposer, hereby certify that a true, correct, and complete copy of the foregoing

AMENDED NOTICE OF OPPOSITION

was served on Applicant's attorney of record at the following address:

Thomas L. Moses
Southeast IP Group LLC
P. O. Box 14156
Greenville, South Carolina 29610

postage prepaid by first-class mail on December 8, 2015.

Executed on December 8, 2015 at Greenville, South Carolina.


Timothy D. St.Clair

Affidavit of Charles Stinnett

1. My name is Charles Stinnett. My address is 341 Laguna Lane, Simpsonville, SC 29680. I have personal knowledge of the facts here stated.
2. On May 9, 2013, I contacted real estate agents Sharon Wilson of Coldwell Banker Caine and Joan Herlong of AugustaRoad.com about potentially listing the condo owned by my wife and me at 160 Ridgeland Drive, Unit 100, Greenville SC, 29601 (Ridgeland at the Park). We met with Ms. Wilson on May 14, 2014, and with Ms. Herlong on May 15, 2013. We subsequently met with an agent from Allen Tate. For a variety of reasons, including inquiries about the possible direct sale of our property without representation by agents, we did not sign the listing agreement with AugustaRoad.com until September 16, 2013.
3. In our May 15 meeting, Ms. Herlong inquired as to other agents we were considering to represent us as sellers. We told her we had met with Ms. Wilson, who had represented a neighbor at Ridgeland, Nelson Arrington, in the sale of their home on Crescent Avenue.
4. During our meeting, Ms. Wilson had said she was the top real estate agent in the Greenville area particularly in the downtown area where our condo was located.
5. I knew she was not the number one agent in our condo development, because the sales had been handled by agents affiliated with C. Dan Joyner. As a member of the original developer appointed board for the Ridgeland at the Park Horizontal Property Regime, I also knew that those owners who were represented by buyers agents had used a variety of agencies and to the best of my knowledge, Ms. Wilson was not among them.
6. Beyond her assertion that she was the number one agent, Ms. Wilson said that what set her apart was her use of social media in attracting potential buyers. Because most of our neighbors were retirees like ourselves or toward the tail end of their careers, we did not feel that social media was an advantage. At the time, she did not offer any opinion as to a listing price for our condo, but said that she would follow up with us on that promptly.
7. On May 15, Ms. Wilson sent me a copy of Coldwell Banker Caine's standard form for listing a property without any of the blanks

completed. Her transmittal email did say that the commission would be 6%.

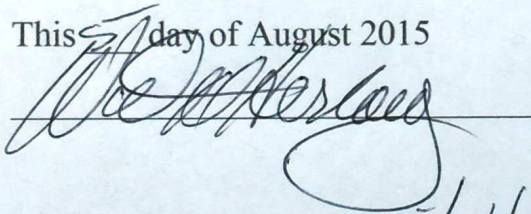
8. Subsequently, I inquired (by phone message as I recall) as to whether she would be providing comps and a suggested price for listing our property, but she did not respond. We felt that was inconsistent with being "number one" of anything.
9. The principal reason I contacted Ms. Wilson in the first place was because I assumed her "Number One in the Neighborhood" ad meant that she was the number one seller in our area.
10. I believe her advertising is misleading.
11. Our condo eventually sold for \$833,000 to a retired couple. Joan Herlong of AugustaRoad.com was our listing agent.
12. I declare under penalty of perjury under the laws of the State of South Carolina that the foregoing statements are true and accurate to the best of my knowledge and belief.



Charles Stinnett

SUBSCRIBED AND SWORN

This 27 day of August 2015



My commission expires: 5/18/22

Affidavit of Margaret Marcum

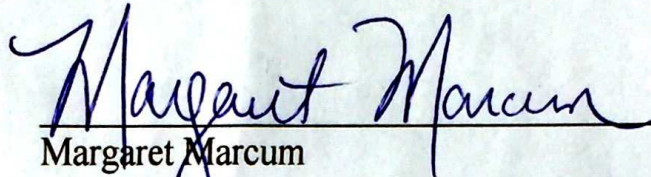
1. My name is Margaret Miller Marcum. I live at 507 Spaulding Lake Drive Greenville SC 29615 (in Spaulding Farm subdivision). I have personal knowledge of the facts stated here.
2. I have been a Realtor in Greenville for 13 years, with Berkshire Hathaway Home Services / C. Dan Joyner for the past 5 years. I have been a consistent top producer (in the top 25 Realtors in Greenville) for at least the past 5 years.
3. In 2014, I served as chairman of the MLS committee of the Greater Greenville Association of Realtors (GGAR).
4. In September 2014, Linda O'Brien, a new agent with Wilson Associates, did a postcard mailing in Spaulding Farm. She was a former resident of Spaulding Farm, but she had not listed or sold anything yet (in Spaulding Farm or anywhere that I know of). Her post card ad (see attached) promoted herself as "Number One in the Neighborhood."
5. I did not receive the post card in the mail; the attached post card was given to me by a neighbor.
6. A former client of mine who lives in Spaulding Farm, called me and asked me if I had seen the post card. I said no.
7. She said, "Linda O'Brien is claiming to be 'number one in the neighborhood.'"
8. This person (whom I would rather not name, so as not to drag her into anything) knew Linda O'Brien, and knew that she had not sold or listed anything in Spaulding Farm.
9. She said "I think this is misleading advertising."
10. At about the same time, the neighborhood newsletter came out, which contained the same ad with the same claim.
11. She is not the only neighbor who called it to my attention. More than one neighbor mentioned the ad(s) to me as misleading, a total of maybe three or four neighbors, I'm not certain as to the exact number, but it's fair to say that several residents noticed the ad and found it misleading. Several other Realtors also brought the "Number One in the Neighborhood" ads to my attention.
12. So I brought the ad to the attention of Nick Sabatine, President of the GGAR, and he suggested I put it on the agenda at the next MLS committee meeting.



13. I did this for two reasons: It is the usual forum for discussing issues like this, and quite often the issue is resolved and it does not have to go any further. First, I did not want to make it personal. Second, residents of Spaulding Farm had called the mailing to my attention because it was not mailed to my home, therefore it was not my personal issue (although I agreed with their objection to the ad). I brought the public's perception of the ad as misleading to the attention of the MLS committee.
14. There was not a lot of discussion about it during the MLS Committee meeting. Nick Carlson of Wilson Associates was also on the MLS committee at the time, and he volunteered to discuss the mailing and the newsletter ad with Sharon Wilson, that they would handle it, and it would stop.
15. Sometime prior to the October 2014 MLS committee meeting, Linda O'Brien of Wilson Associates ran the same ad, again, in the October Spaulding Farm newsletter.
16. I brought it to Nick Sabatine's attention, again, and he suggested that I put it on the MLS Committee agenda, again, in October.
17. At that meeting, Nick Carlson explained that their company had missed the deadline in time to change the ad for the October issue, and he assured the MLS committee that it would not happen again.
18. Shortly after that, I was invited to attend a meeting (in my capacity as chairman of the MLS Committee -- not because I live in Spaulding Farm) with Nick Sabatine, and Nick Carlson and Sharon Wilson of Wilson Associates. I believe the meeting was requested by Sharon Wilson.
19. It did not last long, maybe 10 to 15 minutes.
20. I believe the purpose of the meeting was to reach some kind of compromise regarding the controversial ad/slogan, because our rules are clear: if you run an ad in any medium claiming a rank, you are required to source that claim with MLS statistics for a specific time period and/or area.
21. During the meeting, no one asked about or mentioned Sharon Wilson's sales rank, or her company's sales rank at all, for any time period or for any neighborhood.
22. Sharon Wilson said she felt that "it was legal" for her to use the "Number One" claim with her name or her company, because she had registered it to her name.
23. But we were not there to decide what was legal, or not, so we basically accepted that at face value. We (the MLS committee or the


GGAR) did not have the authority to require Wilson Associates to stop running the ad. Only an ethics hearing has that authority.

24. I felt like it was the only compromise we could get.
25. I declare under penalty of perjury under the laws of the State of South Carolina that the foregoing statements are true and accurate to the best of my knowledge and belief.


Margaret Marcum

SUBSCRIBED AND SWORN

This 7th day of August 2015

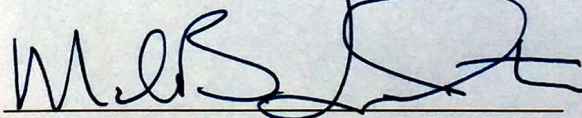


My commission expires: 5/28/19



Affidavit of Mark Johnston

1. My name is Mark Johnston. I am the publisher of the Greenville Journal. I have personal knowledge of the facts stated here.
2. A few years ago Sharon Wilson ran a advertisement in our newspaper which included the line "Number One In The Neighborhood."
3. I heard negative comments on this from a number of realtors, including, specifically, Joan Herlong.
4. As a result, I consulted with Nick Sabatine, the head of the GGAR several times to determine how to proceed. Mr. Sabatine told me that from the GGAR's perspective such a statement needed to be documented with supporting data.
5. Mrs. Wilson's statement "Number One In The Neighborhood" was not documented with supporting data. I therefore informed her that I would not run any ads from her that included that statement.
6. Mrs. Wilson was not happy with my decision, but it was a final decision. I have not reversed the decision and have not run any further ads by Mrs. Wilson or her company including that tagline. I don't know this for sure but I'm confident it is correct. I would think I would have heard from the real estate community again if an ad had run).
7. I have not given Mrs. Wilson any "free" advertising relating to my decision not to run any ads containing the "Number One In The Neighborhood". I recently gave her a "make good" because we put one of her ads in the wrong place in one of our publications. That had nothing at all to do with the "Number One In The Neighborhood" statement which was not in the ad. I have not given her any other free advertisements.
8. I have run several advertisements by Mrs. Herlong which state that she is the number one individual realtor in Greenville and cite MLS data as support.
9. The first time I received such an ad from her, I consulted with Nick Sabatine to make sure it was okay based on my prior conversations with him regarding Mrs. Wilson's advertisement. He confirmed again that as long as the statement was documented and correct, it was okay from the GGAR's perspective. He also confirmed based on MLS data that the statement was in fact accurate. Therefore, I ran the ad.
10. I declare under penalty of perjury under the laws of the State of South Carolina that the foregoing statements are true and accurate to the best of my knowledge and belief.



Mark Johnston

SUBSCRIBED AND SWORN

This 28 day of August 2015

My commission expires: 5/18/22

EXHIBIT C